

REMARKS

Claims 1, 3-9 and 12-15 are pending in this application. Claims 2, 10 and 11 have been canceled.

The Examiner objects to the continuing data provided by Applicants in that it was not consistent with the PTO records. By this amendment the continuing data has been amended to recite "PCT/US04/20752" instead of "PCT/US04/020752".

The Examiner rejects claims 1-15 under 35 USC 112, second paragraph for failing to particularly point out and distinctly claim the invention. Specifically, the Examiner states that it is not clear what the difference is when p=0 and X a bond. Claim 1 has been amended to delete the reference to "or a bond" in the definition of X. The claims are further rejected because it is not clear what is intended by "...carbocyclic or heterocyclic ring optionally interruppted by 1-3 atoms.." in the definition of Y. Applicants have deleted this phrase from the definition of "R' and R₆ taken together with the intervening N," to address the Examiner's concerns. The Examiner indicates that the same problem exists for the definition of "R₂-Q-R₃ form a 3-15 membered carbocyclic or heterocyclic ring.." however, one of ordinary skill in the art would readily understand this upon review of examples 56 and 57 in the specification.

Claims 9-11 are rejected under 35 USC 112, first paragraph, because the specification is not enabling, other than for glaucoma or ocular hypertension, for treating the various disease and preventing repolarization or hyperpolarization of a mammalian cell. Claims 10 and 11 have been herein canceled without prejudice to refile. Regarding claim 9, one of ordinary skill in the art would readily expect upon review of pages 13 and 14 of the specification that the claimed compounds would be useful in treating macular edem, macular degeneration and the like. There is no "prevention" language in claim 9.

Claims 1, 2, 4, 5 and 12 are rejected under 35 USC 102(b) as being anticipated by US 5,990,146; 6,531,484; 6,248,755; 6,352,985; and 4,212,876. The Examiner states that formula I in column 2 of '146 (Boschelli et al.) teaches the instant compounds. However, a more careful review of '146 will reveal that none of the compounds provide for a YR₆ substituent. Regarding '484 (Willoughby et al) and '876 (Houlihan), claim 1 has been amended to recite "provided that when R₄ and R₅ are hydrogen and YR₆ is ethyl then W is not tropine and when R₄ and R₅ are hydrogen and YR₆ is phenyl then W is not C₁₋₄ alkyl" to remove any overlap. No new matter has been added.

Regarding '755 (Chapman), there is no anticipation as the definition of "Y" in the instant invention does not allow for C(OMe)3 as with R' of '755. Additionally, although "W" of the instant invention allows for (CH₂)_nR₉ substitution, wherein R₉ can be piperidyl

and said piperidyl can be substituted with pyrrolidinyl, the pyrrolidinyl cannot be further substituted as required with '755.

Regarding '985 (Yamasaki et al), the Examiner states that '985 teaches the compounds of the instant invention. By this amendment claim 1 has been amended to delete OCOR_3 , COOR , $\text{O}(\text{CH}_2)_n\text{N}(\text{R})_2$, $-\text{O}(\text{CH}_2)_n\text{CO}_2\text{R}$, and $\text{N}(\text{R})_2$, from the definition of R4 and R5 to remove any overlap. R3 of '985 requires a carboxyl, amino or sulfonyl group which the instantly amended invention does not have.

As a result of the amendments and remarks, Applicants believe the examiners concerns have been met and overcome. The examiner is therefore respectively requested to remove the objections and rejections. The Examiner is invited to contact the undersigned attorney at the telephone number provided below, if such would advance the prosecution of this application.

Respectfully submitted,

By

Sylvia A. Ayler
Reg. No. 36,436
Attorney for Applicant

MERCK & CO., Inc.
P.O. Box 2000
Rahway, New Jersey 07065-0907
(732) 594-4909

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